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EXAMINER

SCHEUERMANN, DAVID W

ART UNIT PAPER NUMBER

2834

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/672,313

Applicant(s)

ERIC ERFORTH

Examiner

David W. Scheuermann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24, 26,27,29-33 and 35-39 is/are rejected.
- 7) ☒ Claim(s) 25,28 and 34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

## DETAILED ACTION

### *Drawings*

The drawings are objected to under 37 CFR 1.83(a) because they fail to show the layers of the exciter clearly or their orientation as described in the specification. Figures 4, 8, 9A and 9B are especially unclear. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claims***

There appears to be a typo in the claims. It seems that claim 34 was meant to depend from claim 33 rather than 23. In order to advance prosecution the examiner will treat claim 34 as if it depends from claim 33 in expectation of an amendment in response to this office action to that effect.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-23, and 35-39 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims recite a "direct current operation by inversion of respective magnetic poles". There is neither full nor clear written description describing how this DC voltage is generated. The current in the exciter would increase as the magnet supplied field increases on the approach and decrease after maximum magnet field intensity is reached (when the magnet moves away from the exciter). This results in an alternating current regardless on how the magnets are orientated. Furthermore, it is not clear how the capacitor switching arrangement yields a DC output as no schematic is shown.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-23, and 35-39 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility.

These claims recite a "direct current operation by inversion of respective magnetic poles". There is neither full nor clear written description describing how this DC voltage is generated. The current in the exciter would increase as the magnet supplied field increases on the approach and decrease after maximum magnet field intensity is reached (when the magnet moves away from the exciter). This results in an alternating current regardless on how the magnets are orientated. Thus, one of ordinary skill in the art could not use the invention as described in the current disclosure without undue experimentation.

Claims 1-23, and 35-39 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

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When a patent applicant presents an application describing an invention that contradicts known scientific principles, or relies on previously undiscovered scientific phenomenon, the burden is on the examiner simply to point out this fact to the appellant. The burden shifts to appellant to demonstrate either that his invention, as claimed, is operable or does not violate basic scientific principles, or that those basic scientific principles are incorrect. *As stated by the Patent Office Board of Appeals, Newman v. Quigg 681 F.Supp 16, at 18, 5 U.S.P.Q. 2d 1880(1988).*

**Applicant is required to furnish a working model of their invention** in order to demonstrate its operability. See MPEP § 608.03.

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 30 and 33 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Adám et al., EP429729A1. Adám et al. show:

An exciter 2 coupled configuration of a permanent magnet generator (note the second paragraph in column 2) wherein the exciter configuration comprises:

A frame (inherent);

At least one exciter 2 coupled to the frame; and

at least one lead wire (note leads extending from each end of loops 2), the at least one lead wire coupled to the at least one exciter.

Re claim 33, note that exciter 2 includes a core that is formed of a strip of insulated dynamo sheet rolled into a tight spiral, (see abstract), the insulation would be the thin first material while the iron sheet would be the second material.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31 and 32 rejected under 35 U.S.C. 103(a) as being unpatentable over Adám in view of Nahirney, US 5227702. Adám discloses the invention substantially as claimed as set forth in the rejection of claim 30, supra. Adám does not expressly disclose, "...wherein the at least one exciter comprises at least 120 exciters". Nahirney discloses that different number of electromagnetic coils (exciters) and permanent magnets can be used to design a motor for various applications, for the inherent purpose of optimizing performance. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use 120 exciters on the generator of Adám. One of ordinary skill in the art would have been motivated to do this optimize performance. Furthermore, the courts have established via, *in re Aller*, 105 USPQ 238 (CCPA 1955) the courts have established that, "...even though applicant's modification results in great improvement and utility over prior art, it may still not be patentable if modification was

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within capabilities of one skilled in art; more particularly, where general conditions of claim are disclosed in prior art, it is not inventive to discover optimum or workable ranges by routine experimentation.

Claims 24, 26, 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukada, US 6147415 in view of logical reasoning set forth below.

Fukada shows:

- A permanent magnet generator (see figure 3) comprising:

- A mainframe 31b;

- A first at least one exciter (just above arm 26, figure 3) coupled to the mainframe and residing in a first air gap, the first at least one exciter coupled to at least one lead wire (Inherent. The exciter is attached or connected to a circuit or load. The attachment conductor could properly be called a wire);

- A second at least one exciter (just below arm 26, figure 3) coupled to the mainframe and residing in a second air gap, the second at least one exciter coupled to at least one lead wire (Inherent. The exciter is attached or connected to a circuit or load. The attachment conductor could properly be called a wire);

- A first [reconfigurable] magnet 25;

- A second [reconfigurable] magnet 27;

- A connecting arm 26 coupled to the first [reconfigurable] magnet and the second [reconfigurable] magnet; and

- A drive shaft coupled to the connecting arm. Note that bracketed limitations are not expressly disclosed in Fukada.



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Although the magnets are not expressly disclosed as “reconfigurable”, in column 7 lines, 20-24, permanent magnet attachment plates are mentioned, which would lead one to consider that a damaged magnet could be replaced. Since many of the magnets are the same size as shown in figure 11, for example, it would seem obvious that should one magnet be damaged it would be replaced by an similar magnet. Furthermore, a balanced pair of magnets might be removed, should only one be damaged, to keep the drive shaft balanced while awaiting replacement magnets.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to “reconfigure” the magnets in the generator of Fukada. One of ordinary skill in the art would have been motivated to do this maintain operability while waiting for replacement of a damaged magnet.

Re claim 27, note that roof 11 and support shafts 11 form a housing for the generator.

As to claims 26 and 29, note that there are a plurality of permanent magnets circumferentially disposed as shown in figure 11.

### ***Allowable Subject Matter***

Claims 25, 28 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The limitation, “...wherein the at least one exciter comprises alternating layers of a superconductive material and a

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non-superconductive material," in combination with the remaining structure is neither found nor fairly suggested in the prior art or any combination thereof.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David W. Scheuermann whose telephone number is (571) 272-2035. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren Schuberg can be reached at (571) 272-2044. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1562.

dws  
March 1, 2005

  
DARREN SCHUBERG  
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